

REMARKS

Claims 1-12, 17 and 18, are pending. By this Amendment, no claims are cancelled, amended, or added.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-3, 5, 6, 9-12, 17 and 18 are rejected as anticipated by T'so et. al. '237. Claims 1-4, 6-12, 17 and 18 are rejected as anticipated by Terstappen et. al. '362. Applicant respectfully traverses these rejections and requests that they be withdrawn.

Regarding the rejections over T'so et. al. '237, Applicant notes that the Examiner has conflated the "binding agent" limitation of claim 1 with the separately recited "magnetic bead" in order to facilitate reading claim 1 onto the reference. Final Office Action, p. 3. This is not, however, a "reasonable" interpretation of the claim. Where distinct elements are recited in a claim, they cannot simply be presumed to have the same meaning. See Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 320 U.S. 17, 29 (1997) ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention"). If the "binding agent" and "magnetic bead" elements are interpreted as being separate, as is proper, the Examiner has not identified any disclosure in T'so et. al. '237 corresponding to "contacting an obtained source of cells with a binding agent specific for a cell specific marker associated with a proliferative disorder and expressed by at least some of the cells, wherein the binding agent is bound to a magnetic bead and wherein the binding agent binds to cells in the source expressing the cell specific marker."

Further, the Examiner has simply ignored the limitation of claim 1 requiring "processing the plurality of images to identify the proliferative disorder" because it is an "abstract" step as opposed to an "active" step. Final Office Action, pp. 3-4. The Examiner, however, has not identified any authority allowing claim limitations to be ignored based on whether they are

“abstract” or not, and Applicant knows of no such authority. With this limitation given proper effect, T’so et. al. ‘237 cannot anticipate the claimed invention, because T’so et. al. ‘237 does not disclose processing images to identify a proliferative disorder after imaging.

Based on the foregoing, Applicant respectfully submits that T’so et. al. ‘237 does not disclose all limitations of the claims and therefore cannot anticipate claims 1-3, 5, 6, 9-12, 17 and 18. As a result, Applicant respectfully requests that the rejection over T’so et. al. ‘237 be withdrawn.

As for the rejection over Terstappen et. al. ‘362, Applicant notes that the Examiner appears to ignore the limitations requiring “automatically scanning the microscope slide at a plurality of coordinates using a microscope, automatically obtaining a plurality of images at locations on the microscope slide that comprise the enriched sample, and processing the plurality of images to identify the proliferative disorder.” There is no disclosure in Terstappen et. al. ‘362 of these elements. The passages of Terstappen et. al. ‘362 cited by the Examiner merely suggest some type of examination of a sample using a digital camera or microscope. Terstappen et. al. ‘362 does not disclose, inter alia, automatic scanning at a plurality of locations, automatic acquisition of multiple images at locations with an enriched sample, and processing of the multiple images to identify a proliferative disorder as claimed. Consequently, Terstappen et. al. ‘362 does not anticipate the claimed invention. As a result, Applicant respectfully requests that this rejection be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'B. Thorson', with a long horizontal flourish extending to the right.

Bradley J. Thorson
Registration No. 52,288

Customer No. 24113
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 349-5756